

### **REMARKS**

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 19-47 are presently active in this case. The present Amendment amends Claims 19, 28, 36 and 45 without introducing any new matter or raising new issues.

Claims 19-23, 26-30, 33-42 and 44-47 were rejected under 35 U.S.C. §103(a) as unpatentable over Goldberg et al. (U.S. Patent No. 6,075,844, herein "Goldberg") in view of Culbreth et al. (U.S. Patent No. 5,953,393, herein "Culbreth"). Claims 24-25, 31-32 and 43 were rejected under 35 U.S.C. §103(a) as unpatentable over Goldberg in view of Culbreth and Pflaumer (WO 96/38969).

To clarify Applicant's invention, Claim 19 is amended to recite "a speech recognition module ... configured to enable the transmitting subscriber to edit the list assigned to the transmitting subscriber by means of spoken language."<sup>1</sup> Note that this limitation does not recite a method step, but recites features of the speech recognition module. Independent Claims 28 and 36 are also amended to clarify a feature regarding the editing, in accordance with the amendments to Claim 19. Claims 45-47 are amended to recite "sent by the addressee" for clarification. In light of the amendments to independent Claims 19, 28 and 36, Applicant respectfully traverses the rejection of Claims 19-42 under 35 U.S.C. §103(a) and requests reconsideration of this rejection, as discussed next.

Briefly recapitulating, Applicant's Claim 19 relates to a message exchange connected to a public switched telephone network including a plurality of subscribers. The message exchange system includes: an address module configured to store a plurality of lists with subscriber identifications, each list being assigned to at least one of the subscribers; a receiving module configured to receive a spoken message from one of the subscribers in the

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<sup>1</sup> Finds non-limiting support in Applicant's specification as originally filed, for example from page 6, lines 21 to page 7, line 6.

telephone network via the telephone network, the one of the subscribers being a transmitting subscriber, and to store the spoken message with an identification of the transmitting subscriber; a speech recognition module configured to enable the transmitting subscriber to designate by means of spoken language at least one of the other subscribers as an addressee to whom the spoken message is addressed, and configured *to enable the transmitting subscriber to edit the list assigned to the transmitting subscriber by means of spoken language*; a transmission module configured to transmit the stored message by means of an automatic call to the addressee, and configured to inquire if a reply is to be sent from the addressee to the transmitting subscriber; and a reply module configured to receive and to store the reply from the addressee. Independent Claims 28 and 36 recite similar features in the context of a method of handling spoken messages in a public switched telephone network (Claim 28) and in the context of a computer-readable data carrier (Claim 36).

As explained in Applicant's specification at page 2 lines 9-12 with corresponding Figure 1, Applicant's invention improves upon background message exchange systems, since it proposes a new device and a new method for receiving, storing and transmitting spoken messages in telephone networks which in particular make it possible to receive a message from a plurality of subscribers of a public switched telephone network.

Turning now to the applied references, Goldberg discloses a message system with a remote messaging recording device, such as a portable analog tape recorder or a dictaphone, wherein the message is routed by PC, based on the spoken name of the recipient.<sup>2</sup> However, Applicant respectfully submits that Goldberg does not teach or suggest a speech recognition module configured to enable the transmitting subscriber to edit the list assigned to the transmitting subscriber by means of spoken language, as recited in amended Claim 19. Goldberg's messaging system is able to send a message to a single or multiple recipients by

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<sup>2</sup> See Goldberg in the Abstract and in column 3, lines 31-42.

accessing the corresponding codes from the database.<sup>3</sup> Goldberg also states that “[m]ultiple recipients can be included in the spoken header for a message.”<sup>4</sup> Accordingly, a message merely sent to multiple recipients by including them in the spoken header, as disclosed by Goldberg, *is not* a speech recognition module configured to enable the transmitting subscriber to edit the list assigned to the transmitting subscriber by means of spoken language, as recited in amended Claim 19. Goldberg further recites at column 5, lines 50-54 that “[a]ll of the information required to send a message to an intended recipient is obtained at the time of composing the message.” Accordingly, Goldberg merely enters addresses of recipients at the time of composing the message, and therefore does not have a speech recognition module configured to enable the transmitting subscriber to edit the list assigned to the transmitting subscriber by means of spoken language. Goldberg’s column 6, lines 30-34 explain that the sending party can repeat a recipient’s address if the speech recognition software did not interpret the name correctly, and column 7, lines 25-29 describes the playing back of a recipient’s address to the sender to see who received the message. Accordingly, these passages do not add any features towards Applicant’s claimed speech recognition module configured to enable the transmitting subscriber to edit the list assigned to the transmitting subscriber by means of spoken language.

The applied references Culbreth and Pflaumer do not remedy the deficiencies of Goldberg. Even if assumed that the combination of these two references is proper, the combination fails to teach or suggest the above-noted features on a speech recognition module configured to edit the plurality of lists by means of spoken language. Culbreth discloses a personal telephone agent, wherein a person specifies a message and identifies a list of recipients to his personal messaging agent.<sup>5</sup> Culbreth further teaches that the

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<sup>3</sup> See Goldberg at column 9, lines 5-12.

<sup>4</sup> See Goldberg at column 6, lines 30-34, column 7, lines 25-29, and at column 9, lines 5-12.

<sup>5</sup> See Culbreth in the Abstract and at column 3, lines 29-44.

messaging agent delivers the message and collects a response from each messaging member. A person identifying a list of recipients to his personal messaging agent, as disclosed by Culbreth, *is not* a speech recognition module configured to enable the transmitting subscriber to edit the list assigned to the transmitting subscriber by means of spoken language, as claimed. The reference Pflaumer describes a message transmission system using a telephone network, wherein a message can be sent as acoustic signals.<sup>6</sup> But Pflaumer is silent on features regarding a speech recognition module. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection based on these patents.<sup>7</sup>

Further, Applicant respectfully submits that all the references, Goldberg, Culbreth and Pflaumer, taken individually or in combination, fail to disclose all the features of Applicant's dependent claims.

First, Goldberg does not teach or suggest a speech recognition module is configured to enable the transmitting subscriber to create and administer at least one of the lists by means of spoken language, as claimed by Applicant's dependent Claims 20 and 35. The outstanding Office Action states that Goldberg teaches the message exchange, "wherein the speech recognition module is configured to enable the transmitting subscriber to create and administer the at least one of the lists by means of spoken language."<sup>8</sup> Applicant respectfully disagrees. Goldberg's transmission system includes speech recognition software, which is merely interpreting the identification information for the intended recipient contained in the spoken header of the message.<sup>9</sup> Accordingly, Goldberg *is silent* on the claimed speech recognition module configured to create and administer the plurality of lists. The applied reference Culbreth again does not remedy the deficiencies of Goldberg, since Culbreth

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<sup>6</sup> See Pflaumer in the Abstract.

<sup>7</sup> See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

<sup>8</sup> See the outstanding Office Action at page 4, lines 3-6 pointing out to Goldberg at column 3, lines 55-65.

<sup>9</sup> See Goldberg in the Abstract and at column 4, lines 22-25.

expressively states that a person specifies a message and a list of recipients to his or her personal messaging agent<sup>10</sup> and further teaches that the role of the telephone messaging agent described is simply to deliver messages and record responses, and may be able to interact with the recipients.<sup>11</sup> Accordingly, a personal messaging agent delivering responses to recipients, as taught by Culbreth, *is not* a speech recognition module configured to create and administer the plurality of lists, as would be required to meet Applicant's claimed feature. The reference Pflaumer is silent on features regarding a speech recognition module. Therefore, even if we assume that the combination of Goldberg, Culbreth and Pflaumer is proper, the combination fails to teach every element of the claimed invention. Accordingly, Applicant respectfully traverses, and requests reconsideration of, this rejection of the dependent claims based on these patents.<sup>12</sup>

Second, Goldberg, Culbreth and Pflaumer, taken individually or in combination, fail to teach or suggest that the reply module is configured *to receive the reply from the addressee, said reply being sent by the addressee by means of spoken guidance*, as recited in dependent Claim 45. Dependent Claims 46-47 recite a similar feature. The outstanding Office Action asserts that Goldberg teaches such a feature.<sup>13</sup> Applicant again respectfully disagrees, since Goldberg describes in these passages how a *sending party* composes a message, and the way it should be transmitted, to an addressee. Goldberg thereby states "[t]he sending party can designate their desires for the method of transmission and format for each message."<sup>14</sup> Accordingly, Goldberg, Culbreth and Pflaumer fail to teach or suggest a

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<sup>10</sup> See Culbreth at column 3, lines 34-37.

<sup>11</sup> See Culbreth at column 5, lines 28-56.

<sup>12</sup> See MPEP 2142 stating, as one of the three "basic criteria [that] must be met" in order to establish a *prima facie* case of obviousness, that "the prior art reference (or references when combined) must teach or suggest all the claim limitations," (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

<sup>13</sup> See the outstanding Office Action from page 6, line 20 to page 7, line 1, pointing out to Goldberg at column 7, lines 1-65 and column 9, line 5-12.

<sup>14</sup> See Goldberg at column 7, lines 60-63.

reply module configured to receive the reply from the addressee, said reply being sent by the addressee by means of spoken guidance, as recited in dependent Claim 45.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. §103(a), the present amendment places the application in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues because the changes to Claims 45-47 merely clarifies a minor issue and the changes to Claims 19, 28 and 36 are merely clarifying a feature that has already been considered by the outstanding Office Action. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 19-47 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicant's undersigned representative at the below listed telephone number.

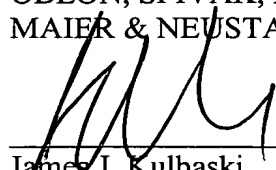
Respectfully submitted,

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